

REMARKS

The Office has made an 18-way restriction requirement in this application. Applicants request reconsideration of this Action and request that the following claim groups be rejoined with each other: Groups I and II and Groups III, IV and XIV.

Group I, claims 1-30, 33 and 34, are drawn to a method of identifying a G protein coupled receptor signaling inhibitor. Claim 29 of Group I recites a screening process which is an enzyme-linked immunosorbant assay with identical steps to the steps of the enzyme-linked immunosorbant assay recited in claim 31 of Group II. Therefore, examination of claim 31 (Group II) with Group I will result in no additional search burden on the Examiner because every limitation of claims 31-32 is contained within Group I.

For a restriction to be proper, not only must the claims be patentably distinct, but there must be a serious burden on the Examiner if the requirement is not made. M.P.E.P. § 2131. In this case, rejoining claims 31-32 to Group I will cause no additional search burden on the Examiner, much less a serious burden. In fact, if the requirement is made, the Office would be required to search the same subject matter twice, resulting in additional workload in the Art Unit.

Applicants therefore request that claims 31-32 of Group II be rejoined at this time and examined together with the elected claims of Group I.

In addition, Applicants request that the claims of Groups III, IV and XIV be rejoined with each other. Group III (claim 35) is drawn to a compound classified in class 530, subclass 2<sup>+</sup> according to the Office Action, page 2. Group IV (claim 36) also is drawn to a compound classified in class 530, subclass 2<sup>+</sup>. Thus, search and examination of these two claims together will not result in any additional burden to the Examiner. Further, each claim is dependent on a claim of Group I, providing additional indication that the claims are closely related to each other. Applicants submit that these claim groups are not properly divided and request reconsideration and rejoinder of claims 35 and 36 in a single claim group.

Group XIV (claim 94) is drawn to "a compound identified by the method of claim 1." Claim 35 of Group III as amended also is drawn to "a compound identified by a method of claim 1." The claims now have identical preambles and before amendment had preambles of the same

scope. Claim 94, however, is a Markush claim which recites a group of compounds (peptides) and thus is narrower. The entire subject matter of claim 94 is contained within the subject matter of claim 35, and therefore cannot result in any additional burden on the Examiner if examined together with claim 35. Applicants therefore submit that these claims are not properly divided and request reconsideration and rejoinder of claims 35 and 94 in a single claim group.

In summary, Applicants request that the claims of Group I and II be examined at this time and that the claims of Groups III, IV and XIV be rejoined in a single group for examination together.

The Office has, in addition to the restriction requirement, made a requirement for election of species at this time. The Office is requiring Applicants to elect a single disclosed species for each of the subgroups 1 through 5 as listed on pages 8-9 of the Office Action. The Examiner has indicated that claims 1, 37, 63, 92, 94 and 96 are considered generic. Applicants make the following species elections as requested by the Office: 1 B (Testing for binding to at least an intracellular fragment of GPCR); 2 Ai (G protein subunit or fragment based on peptide length from 7-70 amino acids); 3 E (Peptide library (candidate compounds)); 4 (e) (Method of measuring signaling activity is measuring ligand binding); 5: LQLNLKKYNRV, compound of SEQ ID NO: 243; 6: minigene construct encoding LQLNLKKYNRV, compound of SEQ ID NO: 243.

Applicants request examination of claims 1-34 at this time and favorable consideration of the application.

<input checked="" type="checkbox"/> Customer Number or Bar Code Label 6449					
Name	Martha Cassidy, Reg. No. 44,066				
Signature			Date	12/16/02	
Address	Rothwell, Figg, Ernst & Manbeck Suite 800, 1425 K Street, N.W.				
City	Washington	State	D.C.	Zip Code	20005
Country	U.S.A.	Telephone	202-783-6040	Fax	202-783-6031

Attachment: Marked up copy of amendments to claims 35-36

2661-101.rrr

In re Gilchrist et al.  
Serial No. 09/852,910  
December 16, 2002  
Marked-Ups Page 1

**Marked Up Copy of Claims 35-36:**

35. (Amended) A compound identified by a method [according to] of claim 1.
36. (Amended) A compound identified by a method [according to] of claim 29.